

Remarks/Arguments

Renumbered claims 14-30 remain in this application. Claim 26 is cancelled. Re-examination and reconsideration are requested.

The Examiner observed that "the numbering of claims is not in accordance with 37 C.F.R. § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution." The present case is a continuation case. Its parent included claims 1-18. Accordingly, the present continuation case included claims originally numbered as 19-35 in conformance with 37 C.F.R. § 1.126. Nevertheless, to avoid ambiguity, the claims that are the subject of this amendment include numbers that correspond to the renumbering scheme proposed by the Examiner.

Claim Rejections - 35 U.S.C. § 103

In paragraph 3 of the Office Action, claims 14-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aoki et al. (WO-95/28509).

Aoki et al. is directed to higher polymer concentrations than those to which the claimed invention is directed. The Examiner agrees: "The applicants claim that the coating has a polymer concentration of 0.01 g/L . . . [and that] . . . Aoki et al. teach polymer concentration amounts of about 2 g/ liter or greater according to the examples (see also column 4, lines 25+)." Office Action, ¶ 5. Noteworthy is that none of Aoki's examples disclose an amount of water-soluble polymer below 2.0 g/L. Accordingly, claim 14 has been amended so that it now calls for 0.01 to 2g/L of polymer molecules. One aspect of this limitation is that low concentrations tend to promote a reduction in industrial waste and off gases, thereby maintaining a satisfactory global environment. See, Specification, p. 1., lines 21-23. For these reasons, the Aoki et al. reference teaches away from the invention as claimed. Accordingly, it cannot be said that the latter is rendered obvious by the former.

The Examiner notes that “. . . Aoki et al. is silent regarding the thickness of the coatings and the amount of carbon present.”, Office Action, ¶ 6, [and that] “. . . it would have been obvious . . . to have varied the concentration of the components used, depending on the thickness of the coating desired, or to have coated the metal with multiple layers . . . depending on the thickness of the desired [coating] for a given application . . .” *Id.*

However, the Specification states that “An excellent adherence by the laminated film is not obtained at coating thicknesses below 5nm, while exceeding 500nm has a high potential for impairing the color of the metal.” Specification, p. 10, ll. 24-26. (emphasis added).

For these reasons, it cannot be said that it would have been obvious to have varied the concentration of the components used, depending on the thickness of the coating desired, or to have coated the metal with multiple layers. This is because the desired properties are not achieved over the entire property spectrum. *See, e.g.*, Comparative Examples 1-3, which resulted in a situation in which “. . . the property spectrum was not satisfied in its entirety by any of the comparative examples . . .” Specification, p. 21.

In light of these differences, it cannot be said that the invention as claimed is rendered obvious by Aoki et al.

Claim 17 of the parent case was allowed. It corresponds to claim 24 of the present case.

All formal and substantive requirements of patentability appear to have been met. A Notice of Allowability is therefore requested.

Respectfully submitted,
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